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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,338	10/19/1999	SEINOSUKE HORIKI	2710/60471	7137

7590 11/04/2002

COOPER & DUNHAM
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NEW YORK, NY 10036

[REDACTED] EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
1773	9

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/403,338	HORIKI ET AL.
	Examiner	Art Unit
	Kevin R Krueger	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 August 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3,5-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 9,10 and 12 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3 and 5-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP06270329 (herein referred to as "Yuka'329"), JP07195870 (herein referred to as "Yuka'870"), JP08121092 (herein referred to as "Yuka'192"), or JP05204609 (herein referred to as "Yuka'609"), in view of Taylor (US 4,292,105) for reasons of record.
2. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuka'329, Yuka'870, Yuka'192, or Yuka'609, in view of Benzinger (US 3,617,613) for reasons of record.
3. Claims 1, 3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuka'329, Yuka'870, Yuka'192, or Yuka'609, in view of Casadevall (US 3,960,626) for reasons of record.
4. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franz et al. (US 3,922,459) in view of Yuka'329, Yuka'870, Yuka'192, or Yuka'609, for reasons of record.
5. Claims 1, 3, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US 3,619,342) in view of Yuka'329, Yuka'870, Yuka'192, or Yuka'609 for reasons of record.

R sponse to Argum nts

Applicant's arguments filed August 21, 2002 have been fully considered but they are not persuasive. Applicant argues that Taylor does not teach the use of phenolic resin. While the examiner concedes that Taylor does not explicitly teach the use of phenolic resin, the examiner maintains the position that the teachings of Taylor are applicable to the Yuka references because Taylor teaches that "the method of the present invention is generally applicable whenever it is desirable to impregnate a fibrous textile material with a solid plastic resinous material... (col 2, lines 6+)." Since the teachings of Taylor seem to be applicable to any thermosetting resin (col 1, lines 16+), the examiner maintains that one of ordinary skill in the art would have expected the B-stage curing of a phenolic resin to ensure long storage life and good moldability.

Applicant points to Example 6 to support their argument. The relevance of Example 6 to Applicant's argument is not clear, but the examiner reminds applicant that the teachings of a reference are not limited only to what is disclosed in the examples. Rather, a reference may be relied upon for all that it fairly suggest to one of ordinary skill in the art.

With respect to Casadevall, Applicant argues there is no teaching of a porous material to be molded, as in the present invention. The examiner agrees. However, Casadevall does teach the impregnation of a porous material with a phenolic resin and the importance of curing said resin to the B-stage to improve handlability. Thus, the examiner maintains the position that Casadevall would have motivated one of ordinary

skill in the art to cure the resin taught in the Yuka references to the B-stage prior to molding.

Applicant further argues that Casadevall does not disclose the addition of an aldehyde and/or aldehyde donor to the taught phenolic resin (claim 8). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner points out that the Yuka references, not Casadevall, was relied upon to teach the aldhehyde and/or aldehyde donor.

Applicant argues that Benzinger utilizes an epoxy, not phenolic, resin in their invention. While epoxy may be utilized in one embodiment, Benzinger also teaches that phenol-formaldehyde may be utilized in the invention (col 6, lines 2+).

With respect to Franz and Burke, Applicant argues that the resins utilized are not cured to the B-stage. However, claims 6-8 do not require that the resin be in the B-stage. To the contray, claims 6-8 state that the resin is cured. Furthermore, the examiner respectfully disagrees with Applicant's assessment of Burke. Burke teaches that the resin should have a specific water solubility. The method in which water solubility would be controlled is by controlling the resin's degree of cure.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is (703) 305-0025. The examiner can normally be reached on Monday-Friday from 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703)305-5436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

X-RX-
Kevin R. Kruer
Patent Examiner


STEVAN A. RESAN
PRIMARY EXAMINER